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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,586	10/11/2001	Peter C. Meltzer	70207/48,913-CON	9855

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[REDACTED] EXAMINER

AULAKH, CHARANJIT

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1625

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/975,586	Applicant(s) Meltzer, P. et al.
Examiner CHARANJIT AULAKH	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM

### THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Oct. 28, 2002

2a)  This action is FINAL.

2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 22-27

is/are pending in the application.

is/are withdrawn from consideration.

4a) Of the above, claim(s) \_\_\_\_\_

is/are allowed.

5)  Claim(s) \_\_\_\_\_

is/are rejected.

6)  Claim(s) 22-27

is/are objected to.

7)  Claim(s) \_\_\_\_\_

are subject to restriction and/or election requirement.

8)  Claims \_\_\_\_\_

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4

6)  Other: \_\_\_\_\_

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## DETAILED ACTION

1. Claims 22-27 are pending in the application.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 22-27 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke ( U.S. Patent no. 3,813,404 ).

Clarke discloses Tropane derivatives ( see col. 1, lines 10-60 ). The disclosed compounds of Clarke ( see examples 1-14 and claims 1-8 ) differ from the instant compounds in having the instant R<sub>2</sub> group as 3-beta isomer instead of 3-alpha isomer. However, Clarke teaches that any stereochemical arrangement of the nucleus and substituents groups is contemplated ( see col. 1, lines 48-50 ). Therefore, it would have been obvious to one skilled in the art to prepare the

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instant compounds having R2 group as 3-alpha isomer by modifying 3-beta isomer since clarke teaches this interchangeability for the substituents as mentioned above.

5. Although applicants have amended specification to claim priority to earlier date yet it is of note that Kuhar ( U.S. Patent no. 6,358,492 ) claims the instant 3 alpha isomers ( see claim 1 ) and therefore, an interference will need to be declared once all other remaining issues ( 103 ) are resolved.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on " Monday-Thursday " from 7:30 A.M. to 6:00 P.M. If the attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Alan Rotman, can be reached on (703) 308-4698. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's receptionist whose telephone number is (703) 308-1235.



CHARANJIT S. AULAKH

PRIMARY EXAMINER